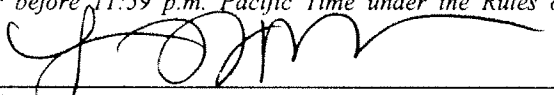


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Signature

Appl No. : 10/681,038
Applicant : Ann Brazil
Filed : October 7, 2003
Title : TIME-OUT EDUCATIONAL SYSTEM

Confirmation No. 2722

TC/A.U. : 3714
Examiner : Scott E. Jones

Docket No. : 50694/B817
Customer No. : 23363

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
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February 7, 2008

Commissioner:

Applicant requests review of the final rejection of claims 1-9 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

Claims 1-9 stand finally rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Sloane, et al. (U.S. Patent No. 5,813,863). Applicant respectfully traverses this rejection.

Applicant's independent claim 1 recites "a method of educating a child using a media presentation device in communication with a user interface, comprising:

identifying a problem behavior exhibited by the child;

selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior; and

presenting the educational time-out presentation to the child through the media presentation device;

wherein the child is educated about the problem behavior and alternate appropriate behavior."

Sloane fails to teach or suggest identifying a problem behavior exhibited by a child, selecting an educational time-out presentation corresponding to that problem behavior, or presenting the educational time-out presentation to the child to educate the child about that problem behavior and alternate appropriate behavior.

In maintaining the rejection over Sloane, the Examiner argues that "Sloane's invention is capable of identifying a problem behavior (e.g. drug use) exhibited by the child" (emphasis in underline added) (Office action, page 2). This argument is improper, as it inappropriately relies on the mere probability or possibility that Sloane's invention includes the claimed limitations. To anticipate a claim, each and every element of the claim must be found either expressly or inherently in a single prior art reference. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999)("Robertson"). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference'" *Id.* at 745 (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991))("Monsanto"). "Inherency, however, may not be established by probabilities or possibilities.'" *Id.* (quoting *Continental Can Co.* at 1269).

Contrary to the requirements set forth in *Robertson* and *Monsanto*, the Examiner has relied on probabilities or possibilities in rejecting the current claims over Sloane. The Examiner has not shown that "the missing descriptive matter is *necessarily* present" in Sloane, but rather only asserts that "Sloane's invention is capable of" including the missing matter. Such reliance on mere probabilities or possibilities is clearly improper, as discussed in *Robertson* and *Monsanto*. As Sloane fails to teach or suggest identifying a problem behavior exhibited by the child, Sloane fails to anticipate the current claims.

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The Examiner also alleges that Sloane discloses "selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior" (Office action, page 2). However, the passages cited by the Examiner (Col. 8: 38 - Col. 9: 39) disclose an "Interactive/Contextual Adventure" through which a user may have a virtual experience and learn the consequences of various dangerous activities, e.g. using drugs. Although the virtual experience may promote awareness and change high-risk behaviors in areas of significant public health concern, Sloane nowhere teaches or suggests selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior.

The Examiner alleges that Applicant misconstrued Sloane and the Examiner's statements regarding Sloane. In particular, the Examiner asserts, "it is not Sloane's system, much less Applicant's claimed invention that identifies a problem behavior exhibited by the child, rather some authority figure identifies the problem behavior. Then the system is used to educate the child or person about the particular behavior problems. Thus, Sloane does anticipate this claim limitation."

Applicant has not misconstrued Sloane nor the Examiner's statements. As noted in paragraph [0025] of the present application, "a caregiver identifies a problem behavior in a child. The caregiver places the child in time-out. The caregiver then selects an educational time-out presentation to present to the child. Selection of the educational time-out presentation is based on the type of misbehavior exhibited by the child (emphasis in underline added)." Accordingly, Applicant is fully aware that a caregiver, and not a "system," identifies the problem behavior and selects the educational time-out presentation. However, the claims at issue recite a method and not a system. "[I]dentifying a problem behavior exhibited by the child" and "selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior" are steps of the claimed *method*. That the system does not perform these tasks is irrelevant. As Sloane fails to teach or suggest a method in which a caregiver or other figure "identif[ies] a problem behavior exhibited by the child" and "select[s] through the user

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interface an educational time-out presentation to present to the child that corresponds to the problem behavior," the present claims are allowable over Sloane.

Additionally, Sloane fails to teach or suggest the limitations recited in dependent claims 2-9. Claim 2, for example, recites that the identifying of the problem behavior further includes "monitoring the child's behavior; and intervening in the child's behavior whereby the child associates the intervention with the problem behavior." The passages of Sloane cited by the examiner disclose only outputs from a media presentation device, and do not disclose monitoring the child's behavior or intervening in the child's behavior, as recited in claim 2. In fact, Sloane nowhere teaches or suggests these method steps. As such, claim 2 is allowable over Sloane.

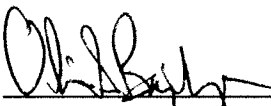
Moreover, dependent claim 3 recites "selecting an educational time-out presentation topic from a plurality of time-out presentation topics presented by the user interface." The Examiner asserts that Sloane discloses this limitation. (Office action, page 3). However, the passage in Sloane cited by the Examiner (Col. 6: 8-12) does not disclose time-out presentation topics. Rather, Sloane discloses four modules: 1) an interactive/contextual adventure; 2) local information; 3) a topical encyclopedia; and 4) subject matter quizzes. These four modules for presenting information are described as "promoting awareness and changing high-risk behaviors in areas of significant public health concern." These modules are not akin to time-out presentation topics presented by the user interface, as recited in claim 3. Therefore, claim 3 is allowable over Sloane.

In addition, claim 4 recites a calming segment. The Examiner alleges that the "teaser video clip set to music" disclosed in Sloane is akin to the calming segment. However, the passage in Sloane cited by the Examiner (Col 5: 52-66) describes the teaser step as being "effective in initially capturing the user's attention." Indeed, as the description "teaser" suggests, the teaser step does not teach calming a child who has already been presented with the presentation, but rather, it is used to capture the attention of a person who has not yet begun the presentation. As such, claim 4 is allowable over Sloane.

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For the reasons stated above, Applicant submits that all of claims 1-9 are allowable over the cited art. Applicant therefore respectfully requests reconsideration of the final rejection of the pending claims.

Respectfully submitted,
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626/795-9900

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